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EXAMINER

PARTON, KEVIN S

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/664,948

Applicant(s)

BARTH, RAINER

Examiner

Kevin Parton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because The only figure should be labeled 'Figure 1' and referred to in the specification as such. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 3, the term "trace file" is not sufficiently described in the language of the claims.

5. Regarding claim 5, the term "bit poll" is not sufficiently described in the language of the claims.

6. Claim 3 recites the limitation "the file" in line 1. There is insufficient antecedent basis for this limitation in the claim. It appears that this claim should have been dependent on claim 2.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Ghanime (USPN 6,591,296).

9. Regarding claim 1, Ghanime (USPN 6,591,296) Teaches a system for control of devices comprising:

- a. A device (*the instruments and computers 108*) to register messages and/or alarms for predefined operating states (*determine whether the sensor signals fall within the acceptable ranges of machine performance*) (column 2, lines 54-55; column 3, lines 46-50).
- b. A converter (*OSM*) to allocate the predefined operating states on an individual basis (*ranges of machine performance, as prescribed in computer databases associated with the OSM*) to the effect that, if one of the predefined operating states is present, the SMS message and/or and email about the one of the predefined operating states is sent to a predefined distribution group (*issue a*

*message to the email server 112 for an email message to be issued)* (column 3, lines 59-62; column 3, line 59 – column 4, line 5).

10. Regarding claim 4, Ghanime (USPN 6,591,296) teaches all the limitations as applied to claim 1. He further teaches an operating keyboard to effect the allocation by editing (*a computer operator associated with the onsite monitor establishes the email addresses for the various machinery units and sensors*) (column 5, lines 36-40).

11. Regarding claim 5, Ghanime (USPN 6,591,296) teaches all the limitations as applied to claim 1. He further teaches means wherein the converter triggers a respective message and/or alarm corresponding to the one of the predefined operating states using a bit poll (*the OSM may include conventional instruments and computers 108 that poll the sensors*) (column 3, lines 40-46).

12. Regarding claim 6, Ghanime (USPN 6,591,296) teaches all the limitations as applied to claim 1. He further teaches means wherein the SMS message and/or the email about the one of the predefined operating states is sent to the predefined distribution group when one of the predefined operating states arises (*as the OSM detects an erratic machine behavior, it remotely notifies via email a remote monitoring and diagnostic center*) (column 3, line 59 – column 4, line 5).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghanime (USPN 6,591,296) in view of Kuwabara (USPN 6,065,136).

15. Regarding claim 2, although the system disclosed by Ghanime (USPN 6,591,296) (as applied to claim 1) shows substantial features of the claimed invention, it fails to disclose means wherein the email has a file attached to it.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ghanime (USPN 6,591,296), as evidenced by Kuwabara (USPN 6,065,136).

In an analogous art, Kuwabara (USPN 6,065,136) discloses a system for email notification of alerts wherein the email has a file attached to it (column 5, lines 15-18, 20-23).

Given the teaching of Kuwabara (USPN 6,065,136), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ghanime (USPN 6,591,296) by employing the use of file attachments in the sending of data. This benefits the system by allowing for different data types and even programs to be sent along with the email alert.

16. Regarding claim 3, although the system disclosed by Ghanime (USPN 6,591,296) (as applied to claim 1) shows substantial features of the claimed invention, it fails to disclose means wherein the file is a trace file.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ghanime (USPN 6,591,296), as evidenced by Kuwabara (USPN 6,065,136).

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In an analogous art, Kuwabara (USPN 6,065,136) discloses a system for email notification of alerts wherein the file is a trace file (column 4, lines 18-23; column 5, lines 15-18).

Given the teaching of Kuwabara (USPN 6,065,136), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ghanime (USPN 6,591,296) by employing the use of a trace file. This type of file benefits the system by allowing for historical tracking of the diagnostic data.

### *Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see the following:

- a. Sandelman et al. (USPN 6,147,601) – System for email notification of alerts.
- b. Wolfe (USPN 6,332,110) – System for remote monitoring of PLCs.
- c. Bereiter (USPN 6,185,606) – System adaptable for remote diagnosis of network elements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (703)306-0543. The examiner can normally be reached on M-F 8:00AM - 4:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703)305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-9242 for regular communications and (703)746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Kevin Parton  
Examiner  
Art Unit 2153

ksp  
July 28, 2003



KRISNA LIM  
PRIMARY EXAMINER